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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,767	10/30/2001	Edward M. Atkinson	226272003310	3324
25226	7590	10/19/2004	EXAMINER	
MORRISON & FOERSTER LLP 755 PAGE MILL RD PALO ALTO, CA 94304-1018			HILL, MYRON G	
			ART UNIT	PAPER NUMBER
			1648	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,767

Applicant(s)

ATKINSON ET AL.

Examiner

Myron G. Hill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8- 34, 50, 51, 53- 92, 118, 119, and 159- 162 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8- 34, 50, 51, 53- 92, 118, 119, and 159- 162 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/14/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

This office action is in response to Amendment B filed 11 October 2002. Claims 8- 34, 50, 51, 53- 92, 118, 119, and 159- 162 are under consideration.

Information Disclosure Statement

A signed and initialed copy of the IDS paper file 14 June 2004 is enclosed.

Response to Amendment

Rejections Withdrawn

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 8, 9, and 17- 20 were rejected under 35 U.S.C. 102(b) as being anticipated by O'Riordan (WO 97/08298).

Applicant's arguments were persuasive in overcoming the rejection. All the limitations of the recited method are not present.

Claim Rejections - 35 USC § 103

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Claims 10- 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over O'Riordan (WO 97/08298).

Applicant's arguments were persuasive in overcoming the rejection. All the limitations of the recited method are not present or obvious.

Claim 21 was rejected under 35 U.S.C. 103(a) as being unpatentable over O'Riordan (WO 97/08298) and Graham (*J. Gen. Virol.*1987, vol. 68 pages 937- 940).

Applicant's arguments were persuasive in overcoming the rejection. All the limitations of the recited method are not present or obvious.

Claims 50, 51, 53- 92 were rejected under 35 U.S.C. 103(a) as being unpatentable over O'Riordan (6/3/1997, WO 97/08298, from IDS), as applied to claims 8, 9, and 17- 20 above and Graham as applied to claim 21 above, and further in view of Shenk (US Pat 5,346,146).

Applicant's arguments were persuasive in overcoming the rejection. All the limitations of the recited method are not present or obvious.

Rejections Maintained

Double Patenting

Claims 22- 34, 118, 119, and 159- 162 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 126

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and 159- 162 of Allowed U.S. Patent Application No. 09/526,333. Although the conflicting claims are not identical, they are not patentably distinct from each other because AAV is purified from the supernatant without a lysis step using anion and cation chromatography.

Applicant has filed a terminal disclaimer.

The response has been considered and is not full persuasive.

A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b). There is no statement accompanying the TD that meets the requirement of 37 CFR 3.73(b).

New Rejections

Claim Objections

Claims 18, 20, 31, and 32 are objected to because of the following informalities: POROS appears to be a trademarked name and the specific product it represents should be recited and the terms HS and SP should be spelled out the first time they are recited in the claims. Applicant is requested to check the claims and determine if any other similar terms are used. Appropriate correction is required.

Claim Rejections - 35 USC § 112

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Claims 8- 34, 50, 51, 53- 92, 118, 119, and 159- 162 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At least claims 8 and 22 recite steps of chromatographing over two resins. The dependent claims vary the order of resins. The claims are chromatographing the "same" lysate in each step. It is suggested that the claims be amended to recite an additional step that results in a/an (enriched? purified) lysate is obtained and then that lysate is used in part (b). The steps in 8 and 22 do not have a required temporal order so switching the order in the dependent claims does not further limit.

Claims 13 and 14 are not clear as to where the step is inserted. In 13, does this step occur prior to lysing? In claim 14, does the step occur prior to (a)? Claim 15 is then not further limiting. In claims 28 and 29 it is not clear at what point the added step is intended to be performed.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myron G. Hill whose telephone number is 571-272-0901. The examiner can normally be reached on 9am-6pm Mon-Fri.

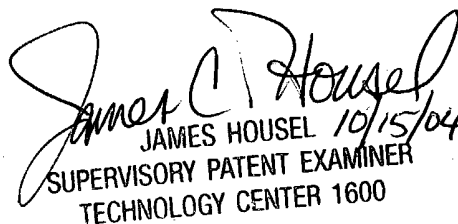
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 571-272-0902. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Myron G. Hill
Patent Examiner
15 October 2004



JAMES HOUSEL 10/15/04
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600